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DURAND, PAUL R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRAD P. BARANOWSKI, DAVID C. BELONGIA,
SCOTT D. WALTER, and APARNA UNNIKRISHNAN

Appeal 2015-003036
Application 13/607,581
Technology Center 3700

Before MICHAEL L. WOODS, LEE L. STEPINA, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Brad P. Baranowski et al. (“Appellants”) appeal under 35 U.S.C. § 134 from the Examiner’s decision rejecting claims 1–18 and 20. Appeal Br. 2. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART, but designate our affirmance of the rejection of claims 13–16 as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Appellants' invention relates to a product dispensing system with "visual communication elements defined by one or more surface variations." Spec. ¶ 4. Claims 1, 13, and 17 are the independent claims, and we reproduce those claims below, with emphases added to particular limitations at issue in this appeal.

1. A product dispensing system, comprising:
a housing having a top wall and a sidewall with at least one orifice and at least one *recessed protrusion in alignment with the at least one orifice*,
wherein an exterior surface of the at least one recessed protrusion provides a visual contrast in color, texture, or surface finish that differs from that of an exterior surface of the sidewall adjacent the orifice.

13. A product dispensing system, comprising:
a housing having a top wall and a sidewall with a product spray opening and at least one surface variation on a first side thereof; and
a manual actuation button extending through the sidewall on a second, different side thereof.

17. A product dispensing system, comprising:
a housing having a sidewall with a surface variation formed at least partially thereby,
which further forms a first communication element; and
a second communication element formed by a dispensing opening,
wherein the first and second communication elements form similarly shaped parts of a pattern.

Appeal Br. 16–19 (Claims App.).

THE REJECTIONS¹

I. Claims 1–3 and 13–15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Gurrisi (US 2007/0241134 A1, published Oct. 18, 2007).

Final Act. 3.

II. Claim 17 stands rejected under 35 U.S.C. § 102(b) as anticipated by Paolazzi (US D604,824 S, issued Nov. 24, 2009). Final Act. 4.

III. Claims 17, 18, and 20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Carpenter (US 2007/0199952 A1, published Aug. 30, 2007).

Final Act. 4–5.

IV. Claims 1–12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over FR493 (FR 1,303,493, published Sept. 14, 1962) and FR703 (FR 1,049,703, published Dec. 31, 1953). Final Act. 5–6.

V. Claims 5 and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gurrisi. Final Act. 8.

¹ In the Answer, the Examiner withdrew a rejection of claims 17, 18, and 20 as being indefinite under 35 U.S.C. § 112, second paragraph. Ans. 7–8

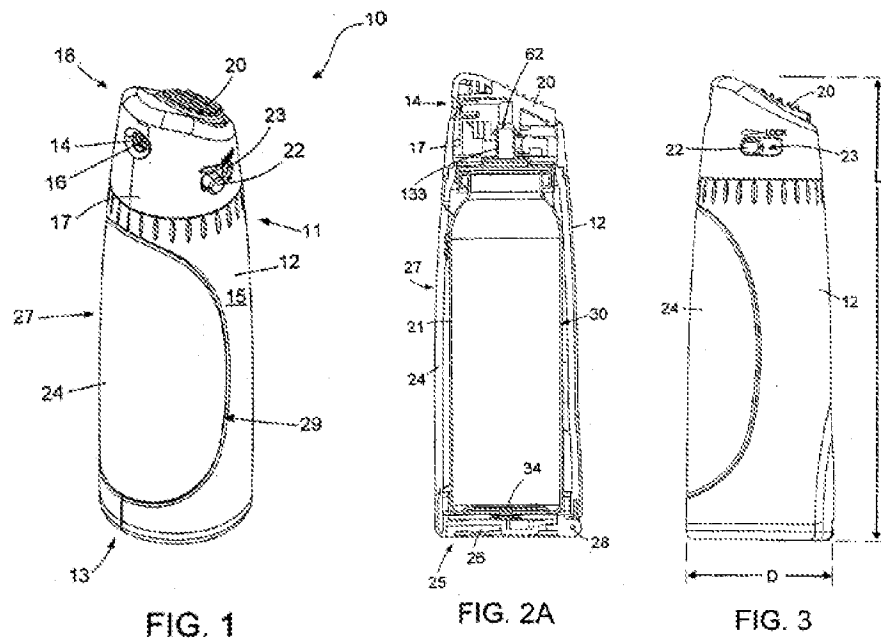
ANALYSIS

Rejection I: Claims 1–3 and 13–15 as Anticipated by Gurrisi

Claims 1–3

Appellants contest the rejection of claims 1–3 collectively. *See* Appeal Br. 11. In accordance with 37 C.F.R. § 41.37(c)(1)(iv), we select claim 1 as the representative claim to decide the appeal of the rejection, with claims 2 and 3 standing or falling with claim 1.

In rejecting claim 1, the Examiner finds that Figures 1 and 2A of Gurrisi disclose the claimed product dispensing system. Final Act. 3. To illustrate this finding, we reproduce Figures 1, 2A, and 3 of Gurrisi, below:



Gurrisi's Figure 1, as found by the Examiner, discloses the claimed dispensing system comprising, *inter alia*, "housing" 12 and sidewall 15. Final Act. 3. Gurrisi's Figure 2A—as found by the Examiner—discloses sidewall 15 as having at least one orifice 29 and at least one recessed protrusion 24. *Id.* Gurrisi's Figure 3 is a side view of the dispenser of

Figure 1. Gurrisi ¶¶ 10–13. The Examiner explains that the “intersection of front and rear portion of 24 creates recess and there is a recess between 24 and opening 29.” Final Act. 3.

In the Answer, the Examiner further cites to Figure 9 of Gurrisi, which we reproduce below (Ans. 10):

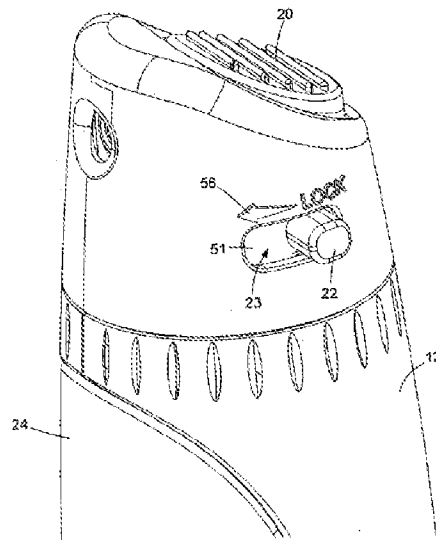


FIG. 9

Gurrisi’s Figure 9, as found by the Examiner, clearly shows “a gap between 24 and 12 created by a tapered portion along the outer edge of 24,” which satisfies the claimed recess. *Id.*

In contesting the rejection of claim 1, Appellants argue that Gurrisi does not disclose the claimed “recessed protrusion,” as Gurrisi’s element 24 is not recessed with the outer surface of housing 12. Appeal Br. 11; *see* Gurrisi Fig. 3 (depicting top surface of “protrusion” 24 as being flush with outer surface of “housing” 12). In support of this argument, Appellants cite to the Specification, which describes, “[s]urface variations include . . . height differences between the portions, such as one portion being recessed.” *Id.* (citing Spec. ¶ 54) (emphasis omitted); *see also* Reply Br. 3–4 (arguing that

the Examiner's interpretation is inconsistent with the Specification (internal citation omitted)).

Appellants' argument is not persuasive. Although we interpret claims in light of the specification, we do not read limitations from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181 (Fed. Cir. 1993).

In the present case, Appellants' argument is premised on an interpretation that the claimed "recessed protrusion" requires that the top surface of the "protrusion" be below the top surface of the sidewall. *See* Appeal Br. 11. The Examiner, on the other hand, finds that Gurrisi's "protrusion" 24 is recessed as a gap exists between the outer edge of "protrusion" 24 and "housing" 12. Ans. 10. Appellants' argument proposes to add disclosed limitations not otherwise expressly recited. In the absence of an express recitation requiring that the surface of the claimed "recessed protrusion" have a different height than the surface of the claimed "housing," we do not interpret the claim so narrowly and as requiring this limitation.

Accordingly, we adopt the Examiner's reasoning and findings and sustain the rejection of claim 1, and claims 2 and 3, which fall with claim 1, under 35 U.S.C. § 102(b) as anticipated by Gurrisi.

Claims 13–15

Appellants contest the rejection of claims 13–15 collectively. *See* Appeal Br. 11–12. Accordingly, we select claim 13 as the representative claim to decide the appeal of the rejection, with claims 14 and 15 standing or falling with claim 13.

In rejecting claim 13, the Examiner finds that Figure 1 of Gurrisi discloses the claimed product dispensing system. To illustrate this finding, we reproduce Gurrisi's Figure 1, below:

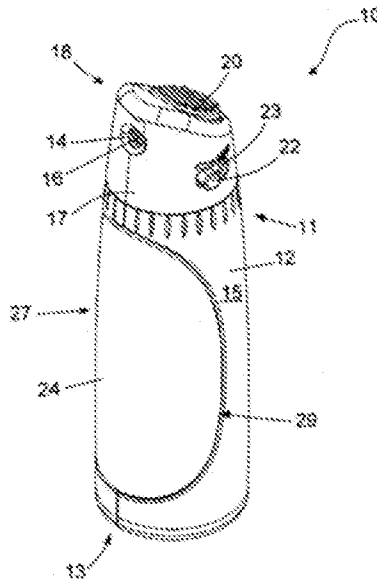


FIG. 1

Gurrisi's Figure 1, as found by the Examiner, discloses the claimed "surface variation" 24 on a "first side thereof," and the claimed "manual actuation button" 22 on a "second side thereof." Final Act. 3.

In contesting the rejection, Appellants provide an annotated copy of Gurrisi's Figure 1, which we reproduce below:

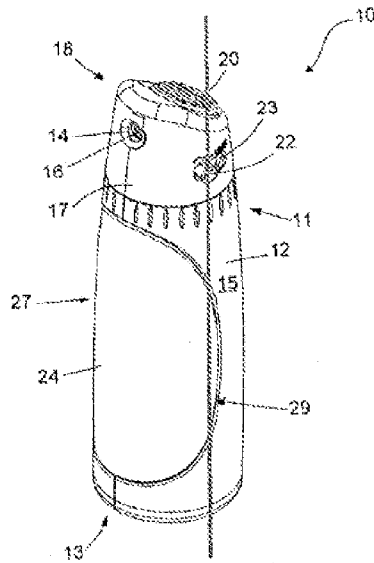


FIG. 1

According to Appellants, and as shown by the vertical line annotation in the above-Figure, Gurrisi’s “manual actuation button” 22 is not aligned with “surface variation” 24, and because of this, Gurrisi does not disclose the claimed “manual actuation button extending through the sidewall on a second, different, side” than the “surface variation’s” 24 side. *See* Appeal Br. 11–12.

In response to Appellants’ argument, the Examiner cites to the location of certain diamond-shaped formations from Gurrisi’s Figure 9—reproduced above—to support a contrary finding that “Figure 1 shows that . . . the left edge of 22 would not be aligned with element 24.” Ans. 10.

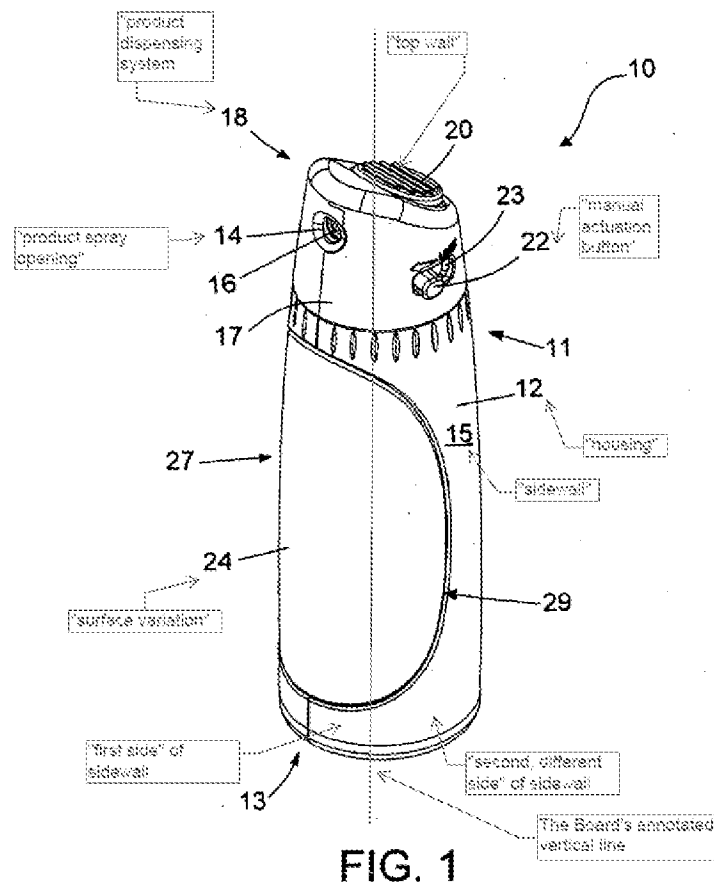
We do not agree with the Examiner’s finding that Gurrisi’s Figure 1 shows that the left edge of “manual actuation button” 22 is not aligned with “surface variation” 24. *See id.*

Although we do not agree with this particular finding, however, we do not interpret the claim so narrowly as requiring the claimed “surface

variation” to avoid, in its entirety, any alignment with the “manual actuation button,” as premised by the Examiner’s finding. *Id.*

Claim 13 specifically recites, “a product spray opening and at least one surface variation on a first side thereof; and a manual actuation button extending through the sidewall on a second, different side thereof.” Appeal Br. 18 (Claims App.). A broad, but reasonable, interpretation of this claim requires simply a first side with a product spray opening and a surface variation, and a second, different, side with a manual actuation button. *Id.* The claim does not require that the surface variation occupy only the first side, thereby prohibiting any portion of the surface variation from also occupying the second side, as the Examiner apparently interprets. *See Ans. 10.* Accordingly, the claimed limitation may be satisfied by a surface variation that occupies *both* the first and second side of the sidewall.

Based on this reasonably broad claim interpretation, we find that Gurrisi’s Figure 1 embodiment discloses the claimed structure. To illustrate these findings, we reproduce our annotated version of Gurrisi’s Figure 1, below:



In particular, we find that Figure 1 of Gurrisi discloses the claimed product dispensing system 18 comprising housing 12, having top wall (adjacent 20), sidewall 15 with a product spray opening 14, and at least one surface variation 24. We also find that this Figure discloses a manual actuation button 22 that extends through the sidewall on a second, different side thereof. The vertical line demarcates the first and second sides. We further find that Gurrisi's transparent viewing element 24 can reasonably be construed as satisfying the claimed "surface variation," as transparent element 24 contrasts with the surface of sidewall 15 that is not transparent. *See* Gurrisi ¶ 33 ("transparent element [24] may occupy as little as 5% of the housing sidewall . . . [and] typically it will be a separate piece affixed or mounted to a similarly dimensioned cut-out [29]"); *see also* Spec. ¶ 54 ("A

surface variation, at a minimum, is one portion of a surface . . . [that] provide[s] a contrast between the surfaces.”).

For the foregoing reasons, we adopt the Examiner’s reasoning and findings and sustain the rejection of claim 13, and claims 14 and 15, which fall with claim 13. Because our analysis relies upon facts and reasoning that the Examiner did not use, however, we designate the affirmance of the rejection as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

*Rejection II: Claim 17
as Anticipated by Paolazzi*

Claim 17 recites, *inter alia*, first and second communication elements that “form similarly shaped parts of a pattern.” Appeal Br. 19 (Claims App.).

To satisfy this claimed limitation, the Examiner cites to Figure 1 of Paolazzi, which we reproduce below:

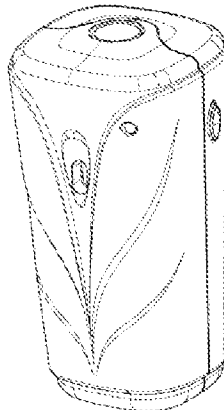


FIG. 1

Paolazzi’s Figure 1, as found by the Examiner, discloses a “first communication element” that “looks like a plant” and a “second

communication element [that is] formed by a dispensing opening . . . [as an] orifice in center of front wall.” Final Act. 4.

Appellants argue that the Examiner errs in relying on dissimilarly shaped features as satisfying the claimed “similarly shaped parts of a pattern.” Appeal Br. 8.

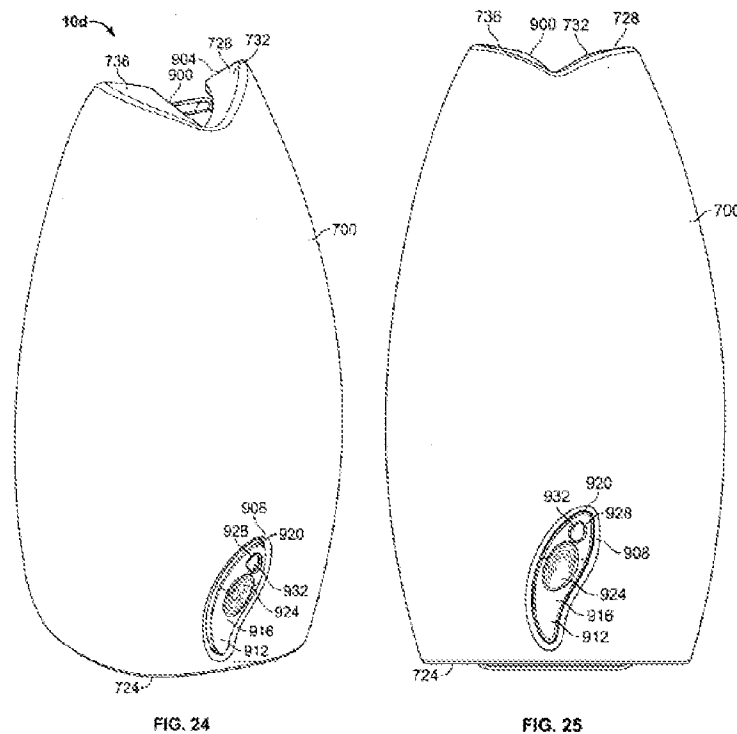
Appellants’ argument is persuasive. We disagree with the Examiner’s finding that Paolazzi’s dispensing opening and Paolazzi’s elements that “look like a plant” together form “similarly shaped parts of a pattern,” as required by the claim. In particular, we do not see how Paolazzi’s oval-shaped opening is “similarly shaped” to the leaf-like elements depicted in Paolazzi’s Figure 1, and we disagree with a finding that together these somehow form a pattern.

For the foregoing reasons, we reverse the rejection of claim 17 as anticipated by Paolazzi.

*Rejection III: Claims 17, 18, and 20
as Anticipated by Carpenter*

Claims 18 and 20 depend from claim 17, which recites, as discussed above, first and second communication elements that “form similarly shaped parts of a pattern.” Appeal Br. 19 (Claims App.).

In rejecting these claims, the Examiner cites to Figures 24 and 25 of Carpenter, which we reproduce below:



The above figures, as found by the Examiner, discloses the “first communication element” as including a “surface variation” formed by elements 728, 736. *See* Final Act. 4–5; *see also* Ans. 9. The Examiner also finds that these figures depict the claimed “second communication element” as formed by “dispensing opening” 900. Final Act. 5. The Examiner explains that “all of the surface variations are have [sic] an elongated or oval shape and form an aesthetically pleasing pattern of a tulip as discussed” in Carpenter’s paragraph 119. Ans. 10.

In contesting the rejection, Appellants argue that the Examiner erred because Carpenter’s “features together form no discernible pattern.” Final Act. 10–11.

Appellants’ argument is persuasive.

We disagree with the Examiner’s findings that Carpenter’s “U-shaped groove” 900 (Carpenter ¶ 120), which the Examiner finds satisfies the

claimed “second communication element” (Final Act. 5), and Carpenter’s elements 728, 736, which the Examiner finds satisfies the claimed “first communication elements” (*id.* at 4), together “form similarly shaped parts of a pattern” (*see* Ans. 9–10). We also disagree with the Examiner’s findings that each of these “surface variations” are “similarly shaped,” as they are each either “elongated or oval shape.” *Id.* at 10. We also disagree with the Examiner’s finding that together these “surface variations . . . form an aesthetically pleasing pattern of a tulip as discussed in Paragraph [0119] of Carpenter.” *Id.* Notably, the cited portion of Carpenter merely describes cover 700 as being “tulip shaped,” not that groove 900, upper end 728, and second portion 736 together form a “pattern of a tulip.” *Compare* Carpenter ¶ 119, *with* Ans. 10.

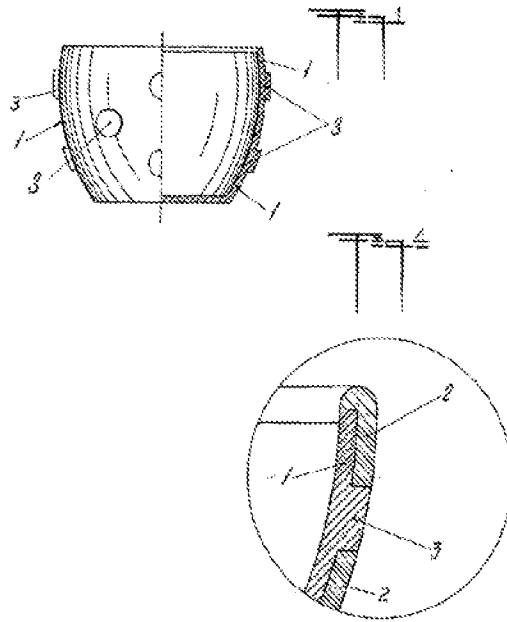
For the foregoing reasons, we reverse the rejection of claims 17, 18, and 20 as anticipated by Carpenter.

*Rejection IV: Claims 1–12
as Unpatentable over FR493 and FR703*

Claims 1–5, 7, and 9–12

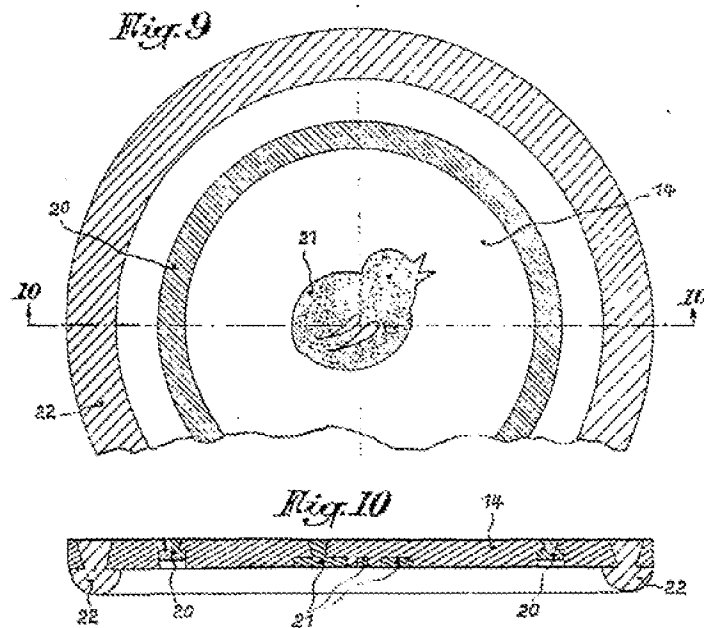
Appellants contest the rejection of claims 1–5, 7, and 9–12 collectively. *See* Appeal Br. 12–13. Accordingly, we select claim 1 as the representative claim to decide the appeal of the rejection, with claims 2–5, 7, and 9–12 standing or falling with claim 1.

In rejecting claim 1, the Examiner relies on Figures 1 and 4 of FR493, which we reproduce below (Final Act. 5–6):



The above figures show—according to the Examiner—a product dispensing system comprising, *inter alia*, a sidewall having “orifice” 2 and at least one “protrusion” 3 in alignment with “orifice” 2. *Id.* The Examiner concedes, however, that FR493 “fails to show that the protrusion is recessed.” *Id.* at 6.

To satisfy this missing limitation, the Examiner relies on Figures 9 and 10 of FR703, which we reproduce below:



The above figures show—according to the Examiner—sidewall 14 having recessed protrusion 20 in an orifice. Final Act. 6.

In combining FR493 with FR703, the Examiner reasons that

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have manufactured some or all of the protrusions of FR493 to be recessed as shown by FR703 to achieve different textures and visual effects resulting in a desired design.

Id.

In contesting the rejection, Appellants argue that the combination would not have been obvious, as FR703’s “‘recessed protrusion’ is disposed beneath the decorated top surface, and in use, would not be seen.” Appeal Br. 12.

Appellants’ argument is not persuasive, as it is premised on a misreading of FR703. Contrary to Appellants’ argument, FR703’s “recessed protrusion” can be seen. Ans. 10 (explaining that although ring 20 is shown

as recessed from the lower surface, this surface was meant to and can be seen).

Accordingly, we adopt the Examiner's reasoning and findings and sustain the rejection of claim 1, and claims 2–5, 7, and 9–12, which fall with claim 1, under 35 U.S.C. § 103(a) as unpatentable over FR493 and FR703.

Claims 6 and 8

Claims 6 and 8 each depend directly from claim 1 and further recite:

6. . . . wherein a plurality of protrusions extend through a plurality of orifices, and *wherein at least one of the plurality of protrusions has a geometric shape that differs from another of the plurality of protrusions.*

...

8. . . . wherein a plurality of protrusions extend through a plurality of orifices, and *wherein at least one of the plurality of protrusions has an orientation with respect to the sidewall that differs from another one of the plurality of protrusions.*

Appeal Br. 17 (Claims App.) (emphases added).

To satisfy these claimed limitations, the Examiner finds that “FR703 shows a plurality of protrusions (20, 21) with different lengths, widths, shapes and orientations (Fig. 10) in order to achieve desired design.” Final Act. 7. The Examiner reasons that

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have manufactured the system of FR193 with at least one of the plurality of protrusions having any of a length and width that differ from another of the plurality of protrusions, a different shape and a

different orientation as taught by FR703 as an obvious design choice to achieve a desired aesthetically pleasing pattern.

Id.

In contesting the rejection of claims 6 and 8, Appellants argue that *even if* reference numeral 20 of FR703 satisfies the claimed “recessed protrusion,” reference numeral 21 does not, as it is instead flush with the bottom surface of the disk. *See* Appeal Br. 13 (citing FR703, Figs. 9, 10).

Appellants’ argument is not persuasive, as the Examiner does not rely on a finding that reference numeral 21 is a “recessed protrusion.” *See* Final Act. 7. To the contrary, the Examiner acknowledges that reference numeral 21 is not recessed (*see* Ans. 11); the Examiner simply relies on this element as having a different length, width, shape, and orientation (*see id.*; *see also* Final Act. 7).

Accordingly, we adopt the Examiner’s reasoning and findings and sustain the rejection of claims 6 and 8 as unpatentable over FR493 and FR703.

*Rejection V: Claims 5 and 6
as Unpatentable over Gurrisi*

Claim 5

Claim 5 depends from claim 1 and further recites, “a plurality of protrusions extend through a plurality of orifices having a complementary shape.” Appeal Br. 16 (Claims App.).

In rejecting claim 5, the Examiner relies on the findings discussed *supra* with respect to Rejection I, claim 1. *See* Final Act. 8. The Examiner acknowledges, however, that Gurrisi fails to teach the claimed plurality of protrusions extending through a plurality of orifices. *See id.*

To satisfy this missing limitation, the Examiner reasons:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have manufactured the system of Gurrisi with a plurality of protrusions as an obvious design choice to allow for viewing of more markings on the can in various locations, especially since it has been held that mere duplication of the working parts of a device requires only routine skill in the art.

Id. (citing Gurrisi ¶ 34, MPEP § 2144.04).

In contesting the rejection, Appellants argue that the Examiner relies on impermissible hindsight, and that using a plurality of protrusions would be both undesirable and impractical. Appeal Br. 13.

Appellants' argument is unpersuasive.

Gurrisi discloses that “the viewing window may be any desired size or shape, [and] preferably it should be sufficient size and shape to enable the user to see external markings . . . on the canister.” Gurrisi ¶ 34. We find that the cited portion of Gurrisi supports the Examiner's reasoning that a person of ordinary skill in the art would have modified Gurrisi to include multiple windows—which satisfy the claimed “recessed protrusions”—in order to “allow for viewing of more markings on the can in various locations.” Final Act. 8.

Accordingly, we adopt the Examiner's reasoning and findings and sustain the rejection of claim 5 as unpatentable over Gurrisi.

Claim 16

Claim 16 depends indirectly from claim 13 and, as with claim 5, further recites, “a plurality of protrusions extend through a plurality of orifices having a complementary shape.” Appeal Br. 18 (Claims App.).

In rejecting claim 16, and as with claim 5, the Examiner relies on the findings discussed *supra* with respect to Rejection I, claim 13, but acknowledges that Gurrisi fails to teach the claimed plurality of protrusions extending through a plurality of orifices. *See* Final Act. 8. As with claim 5, the Examiner reasons that it would have been obvious to add a plurality of protrusions to allow for viewing of more markings. *Id.*

For the same reasons discussed above with respect to claim 5, we also adopt the Examiner's reasoning and findings and sustain the rejection of claim 16. Because our affirmance of the rejection of independent claim 13 relies upon facts and reasoning that the Examiner did not use, however, we also designate the affirmance of the rejection of claim 16, depending from claim 13, as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

SUMMARY

We affirm the Examiner's rejection of claims 1–3 under 35 U.S.C. § 102(b) as anticipated by Gurrisi.

We affirm the Examiner's rejection of claims 13–15 under 35 U.S.C. § 102(b) as anticipated by Gurrisi. However, for the reasons discussed *supra*, we designate our affirmance of the rejection of claims 13–15 as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

We reverse the Examiner's rejection of claim 17 under 35 U.S.C. § 102(b) as anticipated by Paolazzi.

We reverse the Examiner's rejection of claims 17, 18, and 20 under 35 U.S.C. § 102(b) as anticipated by Carpenter.

We affirm the Examiner's rejection of claims 1–12 under 35 U.S.C. § 103(a) as unpatentable over FR493 and FR703.

We affirm the Examiner's rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over Gurrisi.

We affirm the Examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over Gurrisi. However, for the reasons discussed *supra*, we designate our affirmance of the rejection of claim 16 as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

This decision contains NEW GROUNDS OF REJECTION pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] NEW GROUND OF REJECTION pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)